

REMARKS/ARGUMENTS

The Office has erred in withdrawing pending Claims 1-3 and 5-21 from consideration as being directed to a non-elected invention.

The Office based this withdrawal on an alleged election by original presentation, and the alleged patentable distinctness between a product and a process of use. Clearly, the Office did not consider the scope of previously pending and examined Claim 4, drawn to a method.

Claim 4 as examined and rejected in the Official Action of March 19, 2008, read:

Claim 4. A method of forming a silicon-aluminum film, comprising the steps of forming a coating film of the composition for forming a silicon-aluminum film according to Claim 1 on a substrate and treating the film with heat and/or light.

See the Preliminary Amendment filed July 14, 2005. Method Claim 4 was examined and rejected over Haroomi in view of Furasawa and Jones, with the Examiner making particular comments regarding this method claim at page 5 of the Official Action dated March 19, 2008.

As explained at page 7, lines 1-2 of Applicants' last response, Claim 1 was amended to incorporate original Claim 4. Claim 1 now reads:

Claim 1. A method of forming a silicon-aluminum film, comprising:  
forming a coating film comprising a silicon compound and an aluminum compound on a primer coat located on a substrate, said primer coat comprising a metal atom selected from the group consisting of Ti, Pd, and Al; and  
treating the film with heat and/or light.

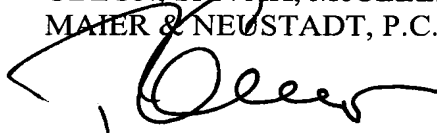
Amended Claim 1 is within the same statutory class as original Claim 4 and directed to the same general subject matter thereof, which was fully considered and examined in the first Official Action.

Thus, to the extent that there was any election by original presentation, a method of forming a silicon-aluminum film as now claimed in pending Claim 1 was part of that original election. Moreover, any patentable distinction between a product and a process of use is meaningless here, where the claim is drawn to method of forming a silicon-aluminum film. As no restriction or election requirement was made prior to the examination of original method Claim 4, the Office cannot now refuse to continue to examine the subject matter of the pending claims.

Accordingly, Applicants request consideration and examination of pending Claims 1-3 and 5-21, and for the reasons presented in Applicants' last Amendment, a Notice of Allowance is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Richard L. Treanor  
Registration No. 36,379  
Attorney of Record

Customer Number  
**22850**